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Scott Montgomery

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EXAMINER

OBEID, MAMON A

ART UNIT

PAPER NUMBER

3621

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,605	Applicant(s) MONTGOMERY ET AL.	
	Examiner MAMON OBEID	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 180-217 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 180-217 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgements

1. This Office Action is responsive to the response filed September 14, 2010 ("September Response").
2. In the September Response, Applicants argue that the final office action mailed June 14, 2010 ("First Final Office Action") did not address newly added claims 216-217. The Examiner agrees and submits that it's an error. Accordingly, the Examiner withdraws the First Final Office Action and Issues herein a second final office action.
3. Claims 180-217 are pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 189 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. No support exists in Applicants' original specification for the limitation "wherein the data received from the vendor-controlled postage-issuing computer system further verifies consistency between the certificate

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serial number contained in the postage indicium and a digital signature derived from the tracking identifier further contained in the postage indicium". If Applicants disagree, Applicants are requested to proper evidence in support thereof. Upon receiving proper evidence, this specific rejection will be withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 180-184, 187-190, 192-197, 198-202, 205-208, 210-215 and 216-217 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of Bailey et al. (U.S. Patent No. 6,925,451 B1)("Bailey")

8. **As per claims 180-181 and 198-199:** Gordon discloses:

a. reading, at the United States Postal Service (e.g. "postal authority 10"), a postage indicium located on a mail piece (e.g. mailpiece) handled by the United States Postal Service, and wherein a postage indicium (e.g. postage indicia)

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contains a certificate serial number and a tracking identifier (e.g. serial or transaction number) (column 3, lines 13-26; figures 6 & 7 and related text);

b. transmitting a request to validate the postage indicium located on the mail piece from the United States Postal Service (e.g. "postal authority 10") to a vendor-controlled postage-issuing computer system ("server 22"), wherein the request to validate the postage indicium includes the tracking identifier contained in the postage indicium located on the mail piece (column 5, lines 21- 33; column 6, lines 1- 6; column 6, line 66-column 7, line 28); and

c. receiving, at the United States Postal Service, data from the vendor-controlled postage-issuing computer system indicating whether the tracking identifier contained in the postage indicium matches any records in a transaction database (e.g. database 20) that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service, wherein the United States Postal Service submits the mail piece for normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier in the postage indicium located on the mail piece does not match any of the records in the transaction database (column 6, line 66-column 7, line 28; column 8, lines 3-14; figures 4, 5 and related text).

9. Gordon further discloses a mailer's computer **12** transmits a request for postage indicia including payment information (e.g. payment request) to the postal authority **10**.

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Once the request for postage has been fully processed within the postal authority, the cryptographically secured or plain text postage indicia is transmitted to the mailer (column 4, lines 30-65). Gordon further discloses encoding postage information in machine readable form (e.g. bar code).

10. Gordon does not expressly disclose a postage indicium (e.g. postage indicia) contains the tracking identifier providing a mail piece tracking capability within the United States Postal Service.

11. However, Bailey clearly discloses a unique tracking ID, wherein the unique tracking ID providing a mail piece tracking capability within the United States Postal Service.

12. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to program Gordon's serial or transaction number to provide tracking functionality similar to the USPS tracking identifier tracking functionality, disclosed by Bailey, to track the progress of the mail piece until it is received by the recipient to comply with the USPS IBIP Requirements of improving productivity and reducing operating cost ("Postal Service -Information Based Indicia Program (IBIP) - Performance Criteria for Information-Based Indicia and Security Architecture for Open IBI Postage Evidencing Systems (BCIBI-O)", USPS, June 25, 1999, pages A1 and C10) ("USPS IBIP Requirements").

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13. Claims 180-184, 187-190, 192-197, 198-202, 205-208, 210-215 and 216-217 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of Applicants-admitted prior art ("APA").

14. **As per claims 180-181 and 198-199:** Gordon discloses:

d. reading, at the United States Postal Service (e.g. "postal authority 10"), a postage indicium located on a mail piece (e.g. mailpiece) handled by the United States Postal Service, and wherein a postage indicium (e.g. postage indicia) contains a certificate serial number and a tracking identifier (e.g. serial or transaction number) (column 3, lines 13-26; figures 6 & 7 and related text);

e. transmitting a request to validate the postage indicium located on the mail piece from the United States Postal Service (e.g. "postal authority 10") to a vendor-controlled postage-issuing computer system ("server 22"), wherein the request to validate the postage indicium includes the tracking identifier contained in the postage indicium located on the mail piece (column 5, lines 21- 33; column 6, lines 1- 6; column 6, line 66-column 7, line 28); and

f. receiving, at the United States Postal Service, data from the vendor-controlled postage-issuing computer system indicating whether the tracking identifier contained in the postage indicium matches any records in a transaction database (e.g. database 20) that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal

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Service, wherein the United States Postal Service submits the mail piece for normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier in the postage indicium located on the mail piece does not match any of the records in the transaction database (column 6, line 66-column 7, line 28; column 8, lines 3-14; figures 4, 5 and related text).

15. Gordon further discloses a mailer's computer **12** transmits a request for postage indicia including payment information (e.g. payment request) to the postal authority **10**. Once the request for postage has been fully processed within the postal authority, the cryptographically secured or plain text postage indicia is transmitted to the mailer (column 4, lines 30-65). Gordon further discloses encoding postage information in machine readable form (e.g. bar code).

16. Gordon does not expressly disclose a postage indicium (e.g. postage indicia) contains a certificate serial number and the tracking identifier providing a mail piece tracking capability within the United States Postal Service.

17. However, APA clearly discloses that certificate serial number and a tracking identifier with tracking capabilities are old and well known in the art (application publication: at least ¶¶ [0005], [0088]).

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18. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to program Gordon's serial or transaction number to provide tracking functionality similar to the tracking identifier tracking capability, disclosed by APA, to comply with the USPS IBIP Requirements of improving productivity and reducing operating cost (see USPS IBIP Requirements, pages A1 and C10).

19. **As per claims 182 and 200:** Gordon further discloses wherein the data received from the vendor-controlled postage-issuing; computer system further represents one or more of an amount, a creation date and time service class, an optional data advance, or a delivery zip code associated with the postage indicium, and wherein the United States Postal Service does not submit the mail piece for the normal delivery if the data received from the vendor-controlled postage-issuing computer system does not match human-readable shipping information further located on the mail piece (column 1, lines 53- 66; column 5, lines 1- 20; column 9, lines 51- 65).

20. **As per claims 183 and 201:** Gordon further discloses wherein the United States Postal Service does not submit the mail piece for the normal delivery if further the tracking identifier contained in the Postage indicium does not match a standard tracking identifier further located on the mail piece (column 1, lines 53- 66; column 10, lines 8- 15; figures 6 & 7).

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21. **As per claims 184 and 202:** Gordon further discloses wherein the United States Postal Service does not submit the mail piece for the normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier contained in the postage indicium located on the mail piece matches one or more of the records in the transaction database (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

22. **As per claims 187 and 205:** Gordon further discloses wherein United States Postal Service scans a two-dimensional bar code further located on the mail piece to read the postage indicium (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

23. **As per claims 188, 192-193 and 210-211:** Gordon discloses as shown above.

24. Gordon does not disclose wherein the data corresponding to the requested postage indicium comprises the indexing tracking identifier and either a meter number or an account number.

25. However, Bailey clearly discloses a meter serial number (column 4, lines 14- 34).

26. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to include a meter

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serial number in postage indicia, as disclosed by Bailey, to increase the postage indicia's security thereby reducing fraud (Bailey: column 4, lines 14- 34).

27. **As per claims 189 and 207:** Gordon further discloses wherein the United States Postal Service obtains the certificate serial number contained in the-postage indicium in response to scanning the two-dimensional bar code, and wherein the data received from the vendor-controlled postage-issuing computer system further verifies consistency between the certificate serial number contained in the postage indicium and a digital signature derived from the tracking identifier further contained in the postage indicium (column 5, lines 1-20).

28. **As per claims 190 and 208:** Gordon further discloses wherein the United States Postal Service scans a two-dimensional bar code further located on the mail piece to provide the postage indicium and obtain the tracking identifier contained in the postage indicium (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8).

29. **As per claims 194 and 212:** Gordon further discloses wherein the United States Postal Service transmits the request to validate the postage indicium to the vendor-controlled postage-issuing computer system and receives the data from the vendor-controlled postage- issuing computer system over a network (column 7, line 65-column 8, line 31; column 9, lines 9- 21; figures 6-8)..

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30. **As per claims 195 and 213:** Gordon further discloses displaying the data received from the vendor-controlled postage issuing computer system at the United States Postal Service (column 2, line 63- column 3, line 12; column 4, lines 30- 46).

31. **As per claims 196 and 214:** Gordon further discloses verifying proof of payment for the postage indicium located on the mail piece from the data displayed at the United States Postal Service, wherein the United States Postal Service submits the mail piece for the normal delivery if the United States Postal Service verifies the proof of payment for the postage indicium with the displayed data (column 2, line 63- column 3, line 12).

32. **As per claims 197 and 215:** Gordon further discloses wherein the data displayed at the United States Postal Service comprises an address for a sender of the mail piece (column 2, line 63- column 3, line 12).

33. **As per claims 216 and 217:** Gordon further discloses wherein the United States Postal Service further assumes that the postage indicium located on the mail piece has not been fraudulently duplicated if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier contained therein does not match any of the records in the transaction database (column 6, line 66- column 7, line 28; column 8, lines 3-14; figures 4, 5 and related text).

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34. Claims 185-186, 191, 203-204 and 209 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon in view of Bailey and further in view of Woods et al (U.S. Patent Application Publication No. 20020152174 A1) ("Woods")

35. **As per claims 185, 191, 203 and 209:** Gordon/ Bailey discloses as shown above.

36. Gordon/ Bailey does not explicitly disclose generating a serial number or transaction number at the postal authority 10 and sending the generated serial number or transaction number to server 22.

37. However, Woods discloses the following:

g. generating the tracking identifier at the United States Postal Service in response to receiving a tracking identifier request (¶ [0054]-[0056]); and

h. sending the generated indexing tracking identifier from the United States Postal Service to the vendor-controlled postage-issuing computer system, wherein the United States Postal Service generates and sends the indexing tracking identifier in response to the tracking identifier request prior to reading postage indicium located on the mail piece (¶ [0054]-[0056]).

38. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a tracking number to be sent to a postage provider, as disclosed by USPS IBIP Requirements or Woods, to comply with the USPS IBIP Requirements to enable a user

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or provider to track a package as its being delivered between the USPS facilities to provide a user-friendly system (USPS IBIP Requirements: pages A1 and C10; Woods: ¶ [0054]).

39. Claims 185-186, 191, 203-204 and 209 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon et al, (U.S. Patent No. 6,527,178 B1) ("Gordon") in view of APA and further in view of USPS IBIP Requirements.

40. **As per claims 185, 191, 203 and 209:** Gordon/APA discloses as shown above.

41. The combination Gordon/APA does not expressly discloses generating a serial number or transaction number at the postal authority pr postal service and sending the generated serial number or transaction number to a server or vendor.

42. However, USPS IBIP Requirements clearly disclose the following:

- i. generating the tracking identifier at the United States Postal Service in response to receiving a tracking identifier request (page C-10); and
- j. sending the generated indexing tracking identifier from the United States Postal Service to the vendor-controlled postage-issuing computer system, wherein the United States Postal Service generates and sends the indexing tracking identifier in response to the tracking identifier request prior to reading postage indicium located on the mail piece (page C-10).

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43. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gordon's teachings to incorporate a tracking number to be sent to a postage provider, as disclosed by USPS IBIP Requirements, to comply with the USPS IBIP Requirements to enable a user or provider to track a package as its being delivered between the USPS facilities to provide a user-friendly system (USPS IBIP Requirements: pages A1 and C10).

44. **As per claims 186 and 204:** Gordon further discloses wherein the United States Postal Service receives the tracking identifier request from the vendor-controlled postage-issuing; computer system and sends the generated tracking identifier to the vendor-controlled postage-issuing computer system in response to the tracking identifier request (column 6, lines 1- 6).

Response to Arguments

45. Applicant's arguments filed September 14, 2010 have been fully considered but they are not persuasive.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

46. Applicants argue (page 13): "Accordingly, for at least the reason that the exemplary passages in Applicants' disclosure provided above (in addition to various other passages) clearly describe a postal verifier using data received from a vendor-

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controlled postage-issuing computer system to verify consistency between a certificate serial number contained in a postage indicium and a digital signature derived from a tracking identifier further contained in the postage indicium, claim 89 complies with the written description requirement. The rejection is therefore improper and must be withdrawn for at least this reason.”

47. However, the Examiner respectfully disagrees. The citations provided by applicants do not provide sufficient support for the claimed limitation. Additionally, the Applicants' specification generally lacks support for the claimed limitations. Therefore, this specific rejection is maintained.

REJECTION UNDER 35 U.S.C. § 103

48. Applicants are reminded that recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

49. In regards to the limitation “certificate serial number”, the Examiner agrees that Gordon does not expressly disclose this limitation. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The information collection and storage steps would be performed the

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same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a "certificate serial number" data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Conclusion

50. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

51. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited in the Notice of References Cited (form PTO-892).

53. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is not a matter of right. "The refusal of an Examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

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54. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to MAMON OBEID whose telephone number is (571)270-1813. The Examiner can normally be reached on Mon-Fri 8 AM- 5:00 PM.

55. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
October 12, 2010

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621